

REMARKS

This application has been reviewed in light of the Office Action dated September 7, 2006. Claims 1-4, 6-10, 12-15, and 17-24 are presented for examination, of which Claims 1, 15, and 22 are independent. Claims 5, 11, and 16 have been cancelled without prejudice or disclaimer. Claims 1-4, 6-10, 12-15, 17-22, and 24 have been amended to define more clearly what Applicants regard as the invention. Claims 25-28 have been added to provide Applicants with a more complete scope of protection. The claim amendments are further discussed below. Favorable reconsideration is respectfully requested.

Initially, in response to the Examiner's objection to the Information Disclosure Statements filed on May 2, 2005 and March 19, 2004, Applicants have filed a Supplemental Information Disclosure Statement on February 5, 2007, along with copies of the cited references, in accordance with 37 C.F.R. § 1.98(a)(2). It is respectfully requested that the information contained therein be considered, and that the Examiner acknowledge the consideration of such information.

Claim Rejections Under 35 U.S.C. § 101

Claims 1-22 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Examiner stated that the claims are not directed towards a final result that is useful, tangible, and concrete. The Examiner requested that limitations of the practical application, result, and concrete, useful, and tangible final result be included in the claim. The Examiner further stated that since the practical application,

result, concrete, useful and tangible limitations are not claimed in Claims 1, 15, and 22, such claims are deemed non-statutory. Applicants respectfully traverse.

To meet the requirements of 35 U.S.C. § 101, "[t]he claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a 'useful, concrete and tangible result.'" M.P.E.P. § 2106(II)(A) (quoting *State Street Bank & Trust v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998)).¹ The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility ("Interim Guidelines") provides the following example of a claimed invention that produces a useful, concrete, and tangible result:

"[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601.

Interim Guidelines, page 39.

Claim 1 recites a method for managing a plurality of data sets on a financial transaction instrument. The method includes the steps of enrolling a first data set owner and a second data set owner in a multiple account management program. The method further includes the step of adding to a database on the financial transaction instrument, a first data set of a first format, wherein the first data set is owned by the first data set owner, and adding to a database on the financial transaction instrument, a second data set of a

¹ The claimed invention must produce a useful, concrete and tangible result; however, the utility of the claimed invention need not be recited in the claim.

second format, wherein the second data set is owned by the second data set owner, the first data set owner is distinct from the second data set owner, and the first format is different from the second format, wherein the first data set is stored in accordance with the first format, and the second data set is stored in accordance with the second format. The method also includes the step of adding a condition header to at least one of the first and second data sets, the condition header identifies a status condition of the at least one of the first and second data sets, and modifying at least one of the first and second data set in the database. Claims 15 and 22 similarly recite these features.

It is respectfully submitted that if "transformation of data. . .into a final share price" is statutory subject matter, then the claimed steps of enrolling data set owners and adding and modifying data sets in a financial transaction instrument to in order to manage a plurality of data sets also is statutory, because these steps produce a "useful, concrete and tangible result", *i.e.*, a financial transaction instrument having at least 2 different data sets in different formats. Thus, Claims 1, 15, and 22 are believed to be directed to statutory subject matter.

Further, the Examiner stated that Claim 1 recites a transaction instrument program and that the components of the transaction instrument are merely software per se. *See* Office Action page 3, line 19. The Examiner also stated that a transaction instrument program must recite physical structure to enable it to be properly categorized in one of the statutory categories of invention and concluded that since the components of the instrument program in Claim 1 are software per se and do not contain any physical components, the

transaction instrument cannot be categorized in one of the statutory categories and is thus non-statutory. *See* Office Action page 3, line 20. Applicants respectfully traverse.

Claim 1, as mentioned above, relates to a method for managing a plurality of data sets on a financial transaction instrument. Generally, the method of Claim 1 comprises the steps of enrolling data set owners and adding and modifying data sets in a financial transaction instrument. Applicants respectfully submit that Claim 1 does not merely claim a software per se. The Interim Guidelines provide:

“A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. § 101. To be statutory, a claimed process must either: (A) result in a physical transformation for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application which produces a useful, tangible, and concrete result.”

Interim Guidelines, page 32, line 22 to page 33, line 4.

Claim 1 requires one or more acts to be performed and thus may be categorized as a process claim. In addition, as mentioned above, the method of Claim 1 produces a useful, tangible, and concrete result, *i.e.*, a financial transaction instrument having at least 2 different data sets in different formats. Thus, Applicants submit that Claims 1, 15, and 22 are directed to statutory subject matter.

Nevertheless, to further emphasize the useful, concrete, and tangible results of the invention, Claim 1 has been amended to recite that the financial transaction instrument is configured to facilitate performing a financial transaction. Support for this amendment may be found, for example, in the specification in paragraphs [0034] and [0056]. Claims 15 and 22 have been similarly amended.

Accordingly, Applicants submit that Claims 1, 15, and 22 meet the requirements of 35 U.S.C. § 101, and withdrawal of this rejection is respectfully requested.

Double Patenting Rejections

Claims 1-24 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-16 of copending Application No. 10/708,550 and as being unpatentable over Claims 12-35 of copending Application No. 10/709,815.

In order to advance the prosecution of the present application and issuance of the claims, Applicants will file a terminal disclaimer should the claims be deemed allowable.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.² Specifically, the Examiner stated that Claim 4 lacks sufficient antecedent basis for the phrase “the financial transaction instrument.” The Examiner also stated that the recitation of the phrase “issuance of the financial transaction instrument by an issuer” renders the claim indefinite because it is not clear who the issuer is. Claim 1 has

² Except for Claims 4, 8, 9, and 11, the Examiner did not provide reasons as to why he rejected Claims 1-16. Therefore, Applicants are not able to respond to the rejections of Claims 1-3, 5-7, 10, and 12-16 under 35 U.S.C. § 112, second paragraph. Should the Examiner maintain these rejections, he is respectfully requested to provide the reasons for the rejections. Of course, should such rejections be repeated in the next Office Action, that Office Action must be made non-final.

been amended to recite a “financial transaction instrument”. Applicant believes such amendment to Claim 1 overcome the rejection of Claim 4 based on insufficient antecedent basis. In addition, the recitation of the phrase “by an issuer” has been removed from Claim 4. Applicants believe that the scope of the claim should not be limited to who the issuer is. The issuer may, for example, be the first data set owner, the second data set owner, or a third party who is not a data set owner. *See e.g.*, specification paragraphs [0023], [0024], and [0044]. Accordingly, Applicants respectfully request that this claim rejection be withdrawn.

The Examiner stated that Claims 8, 9, and 11 lack sufficient antecedent basis for the phrase “the financial transaction instrument.” Claim 11, as noted above, has been cancelled and therefore, the rejection of Claim 11 has been rendered moot. Applicants note that Claims 8 and 9 directly depend from Claim 1. Claim 1 has been amended to recite “a financial transaction instrument,” which provides sufficient antecedent basis for the corresponding recitation in Claims 8 and 9. Accordingly, Applicants respectfully request that this claim rejection be withdrawn.

The Examiner also stated that Claim 22 is indefinite and confusing because it is not clear if the phrase “financial transaction instrument” recited at the end of the claim is the same as the phrase “a transaction instrument” recited at the beginning of the claim. Further the Examiner stated that Claims 23 and 24 are rendered indefinite because they depend from Claim 22. Claim 22 has been amended to uniformly recite “financial transaction instrument” throughout the claim. Accordingly, Applicants respectfully request that this claim rejection be withdrawn.

Prior Art Rejections

Claims 1-3, 5-7, 10, 13, and 15-21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,480,100 (“Frieden”). Claims 4, 8, 9, 11, 12, 14, and 22-24 were rejected under 35 U.S.C. § 103(a) as being obvious over Frieden in view of U.S. Patent No. 5,955,951 (“Wischerop”).

Frieden relates to methods for using an RFID tag associated with a component, and for organizing and storing data on the RFID tag in a user selected format. *See* Abstract and *see generally* column 2, line 63, to column 3, line 6. The selected format may be recorded or stored remote to the tag with a data format name. The data format name may be stored on the RFID tag, such that a tag interrogator retrieving the data format name from the tag may thereafter retrieve and/or load the corresponding data format to property parse and interpret the data stored on the tag in that format. *See generally* column 3, lines 7-24. The methods also include providing more than one data format on a particular tag, wherein each data format is defined by a corresponding user of a particular portion of the tag. *See generally* column 3, lines 29-33 and 62-67. Thus, a tag may include multiple formats to meet the data storage needs of multiple users of a tag. However, Frieden does not teach or suggest “adding a condition header to at least one of said first and second data sets, said condition header identifies a status condition of said at least one of said first and second data sets,” as recited in Claim 1.

The Examiner equates the condition header recited in Claim 1 with the header format of Frieden. *See* Office Action, page 7, lines 7-8. Applicants respectfully disagree. The condition header of the present invention may include, for example, an

indication of the status of the data set or and identifier correlated to a specific issuer or owner of the data. *See* specification paragraph [0058]. The condition header of the present invention may identify status condition of a data set, for example, loaded, initialized, ready, blocked, removable, and deleted. *See* specification paragraphs [0058] and [0084] – [0090]. For example, a loaded status indicates that information related to a data set has been stored in the financial transaction instrument but remains dormant. *See* specification paragraph [0085].

On the other hand, the header format of Frieden, as defined in the specification of Frieden, is the “layout or arrangement of the header blocks, and may include the size and location of each header block.” *See* Frieden, column 5, lines 24-26. Header block “may include all or a sub-divided portion of the memory/storage capacity of the RFID tag. Each header block may be formatted according to a separate, corresponding header format.” *See* Frieden, column 5, lines 20-23. Thus, the header format of Frieden is merely the layout or arrangement of a portion of the memory/storage capacity of the RFID tag. The header format of Frieden does not identify the status condition of a data set. Applicants submit that the header format of Frieden is not similar to the condition header of the present invention. Accordingly, Frieden does not have the claimed element.

For at least the reason stated above, Applicants submit that Claim 1 is patentable over Frieden.

Independent Claims 15 and 22 recite features similar to those discussed above with respect to Claim 1 and are therefore also believed to be patentable over Frieden.

A review of the other cited reference, *i.e.*, Wischerop, has failed to reveal

anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the cited reference.

Claims 22-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,578,808 ("Taylor").

Taylor relates to a data card that may substitute for several single-application cards, thereby performing multiple applications. *See* Abstract. This transaction smartcard includes a microprocessor that may perform numerous applications including, *e.g.*, serving as a credit card, gas card and airline advantage card, while storing data including perhaps a PIN and various records for each separate account. *See generally* column 3, lines 20-40. However, nothing has been found or pointed out in Taylor that would teach or suggest a "data management system comprising: a financial transaction instrument associated with a first data set of a first format and a second data set of a second format, ... wherein at least one of said first and second data sets is annotated with a condition header," as recited in Claim 22.

For at least the reason stated above, it is respectfully submitted that Claim 22 is patentable over Taylor.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Claims 26-28

Claims 26-28 depend from Claims 1, 15, and 22, respectively. Support for the new claims can be found in the specification, for example, in paragraph [0054].

Frieden and Taylor, as understood by Applicants, do not teach or suggest enrolling a first data set owner and a second data set owner in a multiple account management program, “wherein said enrollment of said first data set owner and said second data set owner authorizes said adding of said first data set and said second data set to said database on said financial transaction instrument,” as recited in Claim 26. Accordingly, Applicants submit that Claim 26 is patentable over Frieden and Taylor.

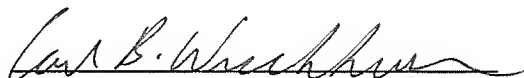
Claims 27 and 28 recite features similar to those discussed above with respect to Claim 26 and are therefore also believed to be patentable over Frieden and Taylor.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Carl B. Wischhusen
Attorney for Applicants
Registration No. 43,279

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_Main 596445_2